

REMARKS

Applicants request favorable reconsideration and allowance of this application in view of the foregoing amendments and the following remarks.

Initially, Applicant notes that the Office Action says an Information Disclosure Statement (IDS) filed on June 2, 1999 has not been considered because it fails to comply with 37 C.F.R. 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. Since no IDS was filed on June 2, 1999, it appears that the Examiner is referring to the IDS filed on December 2, 1999. Moreover, that disclosure statement cites only one document, a co-pending U.S. application, which is properly identified in the IDS in accordance with the rules in effect at that time (that IDS was submitted before implementation of the requirement to submit a copy of each cited co-pending application). Accordingly, Applicant submits that the requirements for consideration of that co-pending application were complied with, and the identified application should be considered. Applicant assumes that this information shall now be considered, unless the Examiner states otherwise in the next communication and provides an explanation of why it was not considered.

The specification has been amended to correct minor errors. No new matter has been added.

Claims 1-13 and 25-47 are pending in this application, with Claims 1, 13, 25, 37, 40-42, 46, and 47 being independent. Claims 14-24 have been cancelled without prejudice.

Claims 1, 3, 5, 7, 8, 10-13, 25, 27, 29, 31, 32, and 34-36 have been amended and Claims 37-47 have been added. Applicants submit that support for the amendments and new claims can be found in the original disclosure, and therefore no new matter has been added.

The drawings have been objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the reference sign I/O Interface 42 mentioned in the description. In response, Applicant has amended the specification at page 3, line 15 to correct a typographical error so that the specification refers to I/O Interface 16, which is shown in Fig. 1. Favorable consideration and withdrawal of the objection to the drawings are requested.

Claims 34, 35, and 36 were objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Those claims have been amended to refer to a program rather than a method. Favorable consideration and withdrawal of the objection are requested.

Claims 1, 13, and 25 were rejected under 35.U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A typographical error has been corrected in each of those claims (specifically, “involved” has been corrected to --invoked--) to clarify the antecedent basis for the phrase “said invoked manipulation.” Reconsideration and withdrawal of this rejection are requested.

Claims 1-4, 13-16, and 25-28 are rejected under 35.U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,362,897 B1 (Berg, et al.). Claims 5-12, 17-24, and 29-36 are rejected under 35.U.S.C. §103(a) as being unpatentable over Berg, et al. in view of U.S. Patent No. 6,222,634 (Dubbels, et al.). Applicant respectfully traverses these rejections for the reasons discussed below.

As recited in Claim 1, the present invention is directed to a method for manipulating an electronic document automatically created by an application program. In conventional methods for manipulating an electronic document, it is sometimes the case that a

software provider may wish to distribute a demonstration version of software, e.g., via on-line distribution, in order to encourage individuals to purchase or subscribe to a full version of the program. To help facilitate this, the present invention as recited in Claim 1 includes the features of identifying a user invoked manipulation of an electronic document to determine if it is one of a predetermined group of manipulations, wherein if it is not a member of the group, the manipulation is allowed to proceed and if the invoked manipulation is a member of the group, the manipulation is allowed to proceed only with respect to a predetermined portion of the electronic document. The predetermined portion is defined by a provider of the application program.

Claims 13 and 25 recite similar features.

Applicant submits that the cited art fails to disclose or suggest at least the above-mentioned features. Berg discloses a system for printing documents and forms in response to user-entered commands, as needed. The software system itself sets the limit on the amount of printing to be done. Berg does not disclose or suggest determining of a user invoked manipulation is a member of a group and allowing the manipulation to proceed, or to proceed with respect to only a portion of an electronic document, based on whether the manipulation is a member of the group.

The other cited art also fails to disclose or suggest at least those features.

Accordingly, Applicant submits that Claims 1, 13, and 25 are patentable over the cited art.

New independent Claims 37, 40, and 41 recite the features of determining whether a plurality of selected documents exceeds a predetermined value and printing a portion of the plurality of selected documents if they exceed the predetermined value. New independent Claims 42 46, and 47 recite the features of determining whether an amount of selected

documents exceeds a predetermined value, the value determined by a provider of an application program, and printing a number of documents up to the predetermined value if the amount of selected documents exceeds the predetermined value, otherwise printing each of the selected documents. Applicant submits that the cited art fails to disclose or suggest at least these features.

Accordingly, the new independent claims are also believed to be patentable.

The dependent claims are patentable for at least the same reasons as the independent claims, as well as for the additional features they recite.

In view of the foregoing, Applicant submits that this application is in condition for allowance. Favorable reconsideration, withdrawal of the outstanding rejections, and an early Notice of Allowance are requested.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



Attorney for Applicant
Brian L. Klock
Registration No. 36,570

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200
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